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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|--------------------------|------------------------------|------------------|
| 10/627,573 | 07/24/2003 | Michael Gerhard Hoffmann | 09879-00034-US AGR2002/M2 | 5228 |
| 23416 | 7590 | 08/04/2005 | EXAMINER | |
| CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899 | | | RAO, DEEPAK R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1624 | |

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,573

Applicant(s)

HOFFMANN ET AL.

Examiner

Deepak Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-22 are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11, 13 and 14 are allowed.
- 6) ☒ Claim(s) 15-22 are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to the amendment filed on May 19, 2005.

Claims 1-11 and 13-22 are pending in this application.

Withdrawn Rejections/Objections:

Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

The terminal disclaimer filed on May 19, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of a patent issued from U.S. Patent Application No. 10/627,256 has been reviewed and is accepted. The terminal disclaimer has been recorded. The provisional obviousness-type double patenting rejection is withdrawn in view of the terminal disclaimer.

The following rejections are necessitated by the amendment:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claims 15-18, a definition has been provided for the variable “R⁸”, however, the structural formula in the claim does not include such variable.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maier et al., EP 1,101,764. The reference teaches 2-aryloxy-pyrazol-1-yl-pyridine compounds that are structurally analogous to instantly claimed compounds. See the structural formula I in page 2 and the corresponding species in Table 1. The compounds are taught to be useful as herbicidal agents, see the abstract. The instant compounds differ from the reference compounds by having the -CF₃ group on the pyrazolyl ring at a position different from the reference compounds, i.e., at the 3-position as compared to 4-position in the instant claims and therefore, the instantly claimed compounds are positional isomers of the reference compounds. It would have been obvious to one having ordinary skill in the art at the time of the invention to prepare the instantly claimed compounds because they are positional isomers of the reference compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such isomeric compounds are suggestive of one another and would be expected to share similar properties and therefore, the same use as taught for the reference compounds, i.e., as herbicidal agents. It has been held that a compound, which is structurally isomeric with a compound of prior art is prima facie obvious absent unexpected results. *In re Finley*, 81 USPQ

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383 (CCPA 1949); *In re Norris*, 84 USPQ 458 (CCPA 1950); *In re Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904 (Fed. Cir. 1990).

Applicant's arguments have been fully considered but they were not deemed to be persuasive. Applicant first argues that 'there is no teaching in the reference that would motivate one of ordinary skill in the art to make the modifications to the reference compounds to prepare the compounds of instant invention'. This is not found to be persuasive because the reference clearly teaches that the disclosed compounds have high herbicidal activity and therefore, are useful in agriculture, for selective control of undesired plants. The instant compound differ from the reference compounds by the position of the $-CF_3$ group on the pyrazolyl ring. From the teachings of the reference, it would have been obvious to one of ordinary skill in the art to change the position of the substituent group or prepare a positional isomer of the reference compound, with the reasonable expectation of obtaining a compound having the similar properties or the same use as disclosed for the reference compounds.

It is to be noted that rejection under 35 U.S.C. 103 is proper where the subject matter claimed "is not *identically* disclosed or described" in the prior art, and the prior art directs those skilled in the art to the compounds, without any need for picking, choosing, and combining various disclosures. See *In re Shaumann et al.*, 572 F.2d 312, 315, 316, 197 USPQ 5, 8, (CCPA 1978). Further, the reference teaches that the compounds are useful as herbicidal agents suitable for the control of undesired plants, which is sufficient to one of ordinary skill to make the claimed compounds because similar properties are normally presumed when compounds are very close in structure.

"Structural relationships provide the requisite motivation or suggestion to modify known

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compounds to obtain new compounds.” See *In re Duel*, 51 F.3d at 1558, 34 USPQ2d at 1214.

The closer the physical and chemical similarities between the claimed species or subgenus and any exemplary species or subgenus disclosed in the prior art, the greater the expectation that the claimed subject matter will function in an equivalent manner to the genus. See *In re Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904. “An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties.” *In re Payne*, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). Reference must be considered, under 35 U.S.C. 103, not only for what it expressly teaches but also for what it fairly suggests; all disclosures of prior art, including unpreferred embodiments, must be considered in determining obviousness. *In re Burckel*, 201 USPQ 67 (CCPA 1979). In the absence of any unexpected results for the claimed compounds, it is maintained that the instantly claimed compounds would have been obvious to one having ordinary skill in the art.

Note: Applicant’s attention is directed to U.S. Patent Application Publications 2004/0198609 and 2004/0198758 which while are not competent references against the instantly claimed invention, claims subject matter that is substantially similar to that claimed herein. Unless applicants can demonstrate that the instant claims are patentably distinct from the claims in this US patent, the only way to overcome these patents is by way of interference proceedings or removal of the conflicting subject matter. See MPEP § 2306.

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Allowable Subject Matter

Claims 1-11 and 13-14 are allowed. Claims 15-19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. The closest reference of record, EP 1101764 teaches pyrazolyl-pyridine compounds useful as herbicidal agents. The reference, however, does not teach or fairly suggest the instantly claimed compounds.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

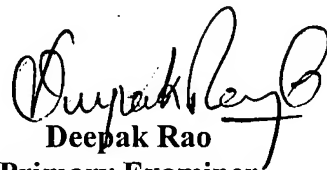
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, Acting-SPE of 1624, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deepak Rao
Primary Examiner
Art Unit 1624

August 1, 2005